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REMARKS

Applicants' representative hereby affirms that election with traverse of claims 1-13 for further prosecution on the merits. Accordingly claims 14-20 are withdrawn from consideration at this time. However, applicants' representative intends to rejoin these non-elected claims upon allowance of the device/system claims currently under consideration. A version of all pending claims is found on pages 2-6. Claim 13 has been amended herein.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 5 - 9, and 11 - 13 Under 35 U.S.C. §103(a)

Claims 1, 5 - 9 and 11 - 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kitano *et al.* (U.S. Patent No. 6,371,667) in view of Tateyama *et al.* (U.S. Patent No. 5,965,200). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Neither Kitano *et al.* nor Tateyama *et al.*, alone or in combination, teach or suggest applicants' claimed invention, let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.

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1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

Independent claim 1 recites *a nozzle that is positionable to dispense liquid to a substrate as well as dispense liquid from a reservoir into a return line...* Likewise, independent claim 13 recites *... means for returning dummy dispensed resist to the reservoir*. Thus, applicants' claimed invention provides for a novel system and/or methodology for mitigating waste of resist as well as occlusion of dispense nozzles. Neither Kitano *et al.* nor Tateyama *et al.* (alone or in combination) teach or suggest such features of applicants' claimed invention.

In particular, Kitano *et al.* pertains to a filming method and a film forming apparatus capable of decreasing the amount of processing solution utilized thereby eliminating waste and forming a uniform processing solution film on a substrate. Kitano *et al.* discloses a catch member to catch resist solution discharged from a resist solution nozzle. However, the catch member as disclosed in Kitano *et al.* is not in fluid communication with any storage means to contain the discharged resist solution. This implies that Kitano *et al.*'s catch member is merely a prophylactic device to prevent discharge of resist solution while the resist solution nozzle is located and centered above the substrate. The recycling of the resist solution in Kitano *et al.* therefore is neither contemplated nor put at a premium. The subject invention on the other hand, is not directed towards *merely* capturing resist *per se*, but rather is directed towards utilizing a near continuous flow of resist – *dummy-dispensed resist* – to prevent drying and formation of resist residues on the dispense head, and consequently returning such dummy-dispensed resist to the system, *via* a storage means, thereby ameliorating wastage of resist.

It is readily apparent that the catch mechanism disclosed in Kitano *et al.*, is not intended to (nor contemplates or suggests) address the issue of capturing dummy-dispensed resist and subsequently returning the aforementioned dummy-dispensed resist to a storage means in order to *prevent the resist from drying and forming residues on*

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the dispense head, which would in consequence *occlude the dispense head orifices*, and which would in turn affect the *amount and pattern by which resist is subsequently dispensed from the dispense head* in the future.

Tateyama *et al.* provides a processing method and processing apparatus that can readily recover a processing liquid used to process an object and can ensure the readiness with which the processing liquid is recycled. In particular, Tateyama *et al.* utilizes a suction nozzle connected to a liquid recycle processing mechanism to recover liquid used during processing. However, Tateyama *et al.*, like Kitano *et al.*, is neither directed towards prevention of the formation of resist residues on the dispense head, nor does Tateyama *et al.* address the issue of occluded dispense head orifices caused by resist drying on the dispense head. Thus, while Tateyama *et al.* may be concerned with the recovery and recirculation of excess liquid used during processing, which would otherwise be wasted, the methods elucidated by Tateyama *et al.*, viz., air ejected from a compressed air source to provide a vacuum, vacuum pumps, and a motor and an aspirator (See Tateyama *et al.*, column 5, lines 55-64), would have a considerable desiccant, and consequently deleterious, effect on *fast drying resist* solutions contemplated in the subject invention. Tateyama *et al.*'s approach rather than aiding in the collection of fast drying resists, would instead hinder such collection and recirculation, by expediting the evaporation of the volatile solvent base from the fast drying resist. Further, by accelerating the evaporation of the volatile solvent base from the resist through the introduction of compressed air sources, vacuum pumps, or motors and aspirators, Tateyama *et al.* would expedite the formation and accretion of resist residues on the dispense head, compounding the occlusion of dispense head orifices by accelerating the dissipation and depletion of the vaporized solvent base atmosphere. Clearly Tateyama *et al.*'s technology is not adapted towards collection and recirculation of surplus resist suspended within extremely volatile solvent bases. The subject claimed invention on the other hand, adopts measures to minimize dissipation and depletion of the volatile solvent base atmosphere, crucially, the subject invention attempts to negate, or at the very least, ameliorate formation and accretion of resist residues on the dispense head and the consequent occlusion of dispense head orifices.

Clearly then, neither Kitano *et al.* nor Tateyama *et al.*, alone or in combination,

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teaches or suggests the applicants' claimed invention. Further, given that Kitano *et al.* is concerned with the minimization of wastage with regards to a processing solution and the forming of a uniform processing solution film on a substrate, but yet, does not disclose a facility to recycle any surplus processing solution that might be generated, and moreover, that Tateyama *et al.* provides a processing method and processing apparatus to recover a processing liquid used to process an object, but discloses a recovery method that is highly impractical with respect to fast drying resists suspended in volatile solvent bases, it is respectfully submitted that there could have been no motivation to impel one ordinarily skilled in the art to combine Kitano *et al.* together with Tateyama *et al.*, to do what the applicants have done.

The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Black Drug*, 786 F.2d at 1143 n.5., 229 USPQ at 187 n.4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

It is therefore, respectfully submitted that any suggestion otherwise would merely be an endeavor to utilize the applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

Finally, in view of at least the foregoing, it is respectfully submitted that neither Kitano *et al.* nor Tateyama *et al.*, alone or in combination, teach or suggest applicants' invention as recited in independent claims 1 and 13, and claims 5-9 and 11-12 which depend from claim 1. Accordingly, it is respectfully requested that this rejection should be withdrawn.

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II. Rejection of Claims 2, 3, and 10 - 12 Under 35 U.S.C. §103(a)

Claim 2, 3 and 10-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kitano *et al.* and Tateyama *et al.* as applied in claim 1 in view of Akimoto *et al.* (U.S. Patent No. 5,938,847). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Neither Kitano *et al.*, Tateyama *et al.* nor Akimoto *et al.*, alone or in combination, teach or suggest the subject invention, let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

As discussed *supra* with respect to independent claims 1 and 13, neither Kitano *et al.* nor Tateyama *et al.*, alone or in combination make obvious the applicants' invention. Claims 2, 3, 10-12 depend from claim 1. Akimoto *et al.* does not make up for the aforementioned deficiencies of Kitano *et al.* and Tateyama *et al.* This rejection should be withdrawn.

III. Rejection of Claim 4 Under 35 U.S.C. §103(a)

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kitano *et al.* and Tateyama *et al.* as applied in claim 1, in view of Tholome (U.S. Patent No. 4,785,760). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. As discussed earlier, the teachings of neither Kitano *et al.* nor Tateyama *et al.*, alone or in combination, teach or suggest applicants' invention as recited in claim 1. Tholome *et al.* is insufficient to overcome the deficiencies in obviousness enunciated above in connection with the combination of Kitano *et al.* and Tateyama *et al.*

In view of the foregoing it is respectfully requested that this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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